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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/171,625 07/02/99 KOSTER

H 24743-2302US

EXAMINER

HM22/0905

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PERSONAL UNIT

ART UNIT

PAPER NUMBER

1627

DATE MAILED:

09/05/00

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.

09/171,625

Applicant(s)

Koster et al

Examiner

P. Ponnaluri

Group Art Unit

1627



☐ Responsive to communication(s) filed on _____

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire _____ month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

☒ Claim(s) 1-36 is/are pending in the application.

Of the above, claim(s) _____ is/are withdrawn from consideration.

☐ Claim(s) _____ is/are allowed.

☐ Claim(s) _____ is/are rejected.

☐ Claim(s) _____ is/are objected to.

☒ Claims 1-36 are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been
☐ received.

☐ received in Application No. (Series Code/Serial Number) _____.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☐ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

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Please Note: In an effort to enhance communication with our customers and reduce processing time, a dedicated Fax machine is in place to receive your responses. The Fax number is 703-308-4315. A Fax cover sheet is attached to this Office Action for your convenience. We encourage your participation in this Pilot program. If you have any questions or suggestions please contact Jyothsna Venkat, Ph.D., Supervisory Patent Examiner at jyothsna.venkat@uspto.gov or 703-308-2439. Thank you in advance for allowing us to enhance our customer service. Please limit the use of this dedicated Fax number to responses to Written Restrictions.

Election/Restrictions

1. Restriction is required under 35 U.S.C. 121 and 372.

This application contains the following inventions or groups of inventions which are not so linked as to form a single general inventive concept under PCT Rule 13.1.

In accordance with 37 CFR 1.499, applicant is required, in response to this action, to elect a single invention to which the claims must be restricted.

Group I, claim(s) 1, 3-4, 11-16, drawn to a process of generating a combinatorial set of core molecules of core structure M and a combinatorial set of compounds with core structure M.

Group II, claim(s) 2, 5-16, drawn to a process of generating a combinatorial set of oligomers.

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Group III, claim(s) 17-19⁻²², drawn to a composition comprising an oligonucleotide which further comprises monomers of formula 49a.

Group IV, claim(s) 23-35³⁶₁, drawn to a combinatorial set of compounds with core structure M.

2. The inventions listed as Groups I-III and IV do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, they lack the same or corresponding special technical features for the following reasons: the special technical feature of group I is a process of generating combinatorial set of molecules of core structure M; and the special technical feature of group II is a process of generating oligomers: the special technical feature of group III is oligonucleotide comprising monomers of formula 49a; and the special technical feature of group IV is a combinatorial set of compounds with core structure M. Since the special technical feature of group I is known in the art (see Carell et al., Angew. Chem. Int. Ed. Engl. 1994, vol. 33, no. 20, pages 2059-2061), the inventions lack unity.

3. This application contains claims directed to more than one species of the generic invention. These species are deemed to lack unity of invention because they are not so linked as to form a single general inventive concept under PCT Rule 13.1.

The species are as follows:

A. If group I is elected, applicants are requested to elect a single species for the following:

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a) Applicants are requested to elect single species of low molecular weight compound of claim 4.

b) Applicants are requested to elect single species of reactive moieties of claim 11.

c) Applicants are requested to elect single species of linkage of claim 16.

B. If group II is elected, applicants are further requested to elect a single species of each of the following:

a) Applicants are requested to elect single species of oligomeric compound of claim 6.

b) Applicants are requested to elect single species of modified base of claim 10.

c) Applicants are requested to elect single species of reactive moieties of claim 11.

d) Applicants are requested to elect single species of linkage of claim 16.

C) If group III is elected applicants are further requested a single species of each of the following:

a) Applicants are requested to elect either B or B^{R2A} or B^{R2B}; and one single group representing them.

b) Applicants are requested to elect either R^{4A} or R^{4B}; and one single group representing them.

c) Applicants are requested to elect R^{2A} or R^{2B}; and one single group representing them.

d) Applicants are requested to elect a single group representing R³.

e) Applicants are requested to elect a single species of reactive moieties of claim 24.

f) Applicants are requested to elect a single species of compounds of claim 26.

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- g) Applicants are requested to elect a single species of oligomeric compound of claim 27.
- h) Applicants are requested to elect a single species of bases of claim 31.

The different groups claimed are distinct from each other because they are structurally different and do not require the other for ultimate use, the species election for examination purposes as indicated is proper.

Applicant is required, in reply to this action, to elect a single species to which the claims shall be restricted if no generic claim is finally held to be allowable. The reply must also identify the claims readable on the elected species, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered non-responsive unless accompanied by an election.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

- 4. The claims are deemed to correspond to the species listed above in the following manner:

The following claim(s) are generic: 1-3, 5, 12-15, 19, and 23

- 5. The species listed above do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, the species lack the same or corresponding special

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technical features for the following reasons: the special technical feature of each group is different and do not require the other for ultimate use. So species election among the above is proper.

6. Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

7. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a petition under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(I).

8. Applicant is required to reply to this restriction requirement within 30 days of mailing this action. See MPEP 809.2(a).

Any inquiry concerning this communication should be directed to P. Ponnaluri whose telephone number is (703) 305-3884. The examiner can normally be reached on Monday through Friday from 8:00 am to 4:30 pm.

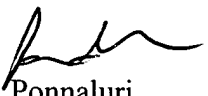
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jyothsna Venkat, can be reached at (703)308-2439. The fax number for this group is (703)305-3014.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the group receptionist whose telephone number is (703)308-0196.



P. Ponnaluri
Patent Examiner
Technology center 1600
Art Unit 1627
25 August 2000